

### **REMARKS/ARGUMENTS**

This application has been reviewed in light of the Office Action mailed on December 28, 2009. Claims 1-5, 7, 8, 21-23, and 26-28 are pending in the application with Claims 6 and 9-20 being previously withdrawn from consideration and with Claims 1, 21, 22 and 23 being in independent form. Claims 1, 21, 22 and 23 have been amended by the present amendment. No new matter has been added. In view of the amendments and remarks to follow, allowance of this application is respectfully requested.

#### **Claim Rejections – 35 U.S.C. §112**

In the Office Action, Claims 1-5, 7, 8, 21, [22,] 23 and 26-28 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, it was asserted that there "is no support in the originally filed specification for an elastomeric material that completely surrounds the electrode (claims 1, 21 and 23), or for the delivery of energy in a unidirectional manner (claim 22) as now set forth in the claims." In the interest of expediting prosecution, each of these limitations has been cancelled by the present amendment, thus rendering the rejection thereto moot.

#### **Drawings**

In the Office Action, the drawings were objected to under 37 CFR 1.83(a). It was asserted that the electrode completely surrounded by the elastomeric material was not shown in the drawings. As discussed above, in the interest of expediting prosecution,

this claim limitation has been cancelled from the claims, thus rendering the objection to the drawings moot.

**Claim Rejections – 35 U.S.C. §103(a)**

In the Office Action, Claims 1-3, 8 and 21-23 and 26-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,770,072 to Truckai et al. ("Truckai") in view of U.S. Patent No. 5,810,811 to Yates et al. ("Yates").

Initially, with regard to Claim 23, as previously presented, Claim 23 recited a tissue or vessel sealing instrument comprising electrodes that are "substantially longitudinally aligned and being offset a distance X relative to one another" and "the distance X being variable depending on the thickness of the tissue between the jaw members." Support for this recitation can at least be found in the paragraph bridging pages 20 and 21 of the application, where it states in part:

Moreover, it is envisioned that the jaw members 110, 120 may be constructed such that the distance "X" is variable depending upon tissue thickness. This can be accomplished by constructing the electrodes 116, 126 such that at least one is moveable transversely across the sealing surface or by having an array of electrodes across the sealing surfaces 115, 125. When utilizing an array of electrodes, each electrode is electrically coupled to the generator 12 to automatically select the appropriate opposing electrode pairs to effect the proper seal across the tissue depending upon the tissue thickness and tissue type.

In the Office Action, neither Truckai nor Yates was relied on to disclose that the distance X is variable. After carefully reviewing both Truckai and Yates, none of these references teach, disclose or even remotely suggest this feature. For at least this

reason, Applicants respectfully submit that Claim 23 is allowable under 35 U.S.C. §103(a) over Truckai in view of Yates.

With regard to independent Claims 1, 21 and 22, each of Claims 1, 21 and 22 has been amended herein to recite that "the distance X is variable." As discussed above with regard to the rejection of Claim 23, neither Truckai nor Yates teaches, discloses or remotely suggests that "the distance X is variable." Therefore, Applicants respectfully submit that each of Claims 1, 21 and 22 is allowable under 35 U.S.C. §103(a) over Truckai in view of Yates.

Since Claims 2, 3, 8 and 26-28 depend from Claim 1 and contain all of the limitations of Claim 1, the subject matter of each of Claims 2, 3, 8 and 26-28, as a whole, is also allowable under 35 U.S.C. §103(a) over Truckai in view of Yates.

In the Office Action, Claim 1-5, 7, 8 and 21-23 and 26-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yates in view of U.S. Patent No. 6,932,816 to Phan ("Phan"). Phan was relied on to teach "that it is advantageous to provide the jaw member with an elastomeric material (106) made from silicone or silicone polymers." Phan fails to teach, disclose or even remotely suggest that the distance X between electrodes is variable. For at least this reason, Applicants respectfully submit that independent Claims 1, 21, 22 and 23 are allowable under 35 U.S.C. §103(a) over Yates in view of Phan. Since Claims 2-5, 7, 8 and 26-28 depend from Claim 1 and contain all of the limitations of Claim 1, the subject matter of each of Claims 2-5, 7, 8 and 26-28, as a whole, is also allowable under 35 U.S.C. §103(a) over Yates in view of Phan.

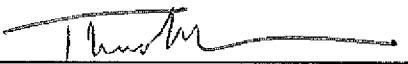
**CONCLUSION**

In view of the foregoing, it is respectfully submitted that all claims presently pending in the application, namely Claims 1-5, 7-8, 21-23, and 26-28, are in condition for allowance.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call the Applicants' undersigned attorney at the Examiner's convenience.

Please charge any deficiency as well as any other fee(s) that may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 50-5016.

Respectfully submitted,

  
Thomas A. Beaton  
Reg. No. 46,543  
Attorney for Applicants

Date: 3/25/10

**Correspondence address:**

**COVIDIEN**  
Energy-Based Devices  
Attn: IP Legal  
5920 Longbow Drive  
Mail Stop A36  
Boulder, CO 80301